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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,442

12/20/2005

Hee-Young Lee

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29338

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12/28/2009

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EXAMINER

WAGGLE, JR, LARRY E

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

12/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,442	Applicant(s) LEE, HEE-YOUNG	
	Examiner Larry E. Waggle, Jr	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 November 2009 has been entered.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Drawings

The drawings are objected to because Figure 1 is cut off at the bottom of the page thereby not showing some details. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy

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must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "hole formed through the cutter," as in claim 5, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note: The objection regarding the bottom of Figure 1 being cut off was not received as an amendment as stated by the applicant in the remarks submitted on 16 November 2009 and the objection regarding the claimed subject matter of claim 5 not being shown was not addressed.

Claim Objections

Claim 1 is objected to because of the following informality:

The amendment includes "a plurality of non-plugging holes are formed through a cutting plane and between a cutting blade formed at a lower portion of the cutter." It appears impossible to the examiner that a plurality of non-plugging holes are formed between a single cutting blade. For an item to be "between" it should be located relative to two or more other items. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schechter et al. (US Patent 5643304).

In the embodiment of Figure 4, Schechter et al. disclose a bone contouring device using a hollowed rasp provided with non-plugging holes (109) formed through a cutting plane, comprising a rasp including a rod (78) connected to an adaptor (77) of a powered surgical handpiece (11), and a cutter (106) provided with a plurality of grooves

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connecting a cavity (108; i.e. saline solution feeding passage) to a cutting blade (107) formed at a lower portion of the cutter, a saline solution feeding passage (108) formed in the cutter and a bone fragment exhausting passage (82) between the cutter and an external jack (23); a powered surgical handpiece (11) connected to the rasp; a saline solution feeding unit (35); a bone fragment collector (25) connected to a suction unit (28); and a protector (15), formed to have a cylindrical shape, wherein bone cutting is performed under the condition that the saline solution is fed into the rasp, the cut bone fragments are exhausted to the outside together with the saline solution, so that the bone cutting is continuously performed and the saline solution feeding passage and the bone fragment exhausting passage are extended to the outside of the cutter (Figures 1-4 and column 4, line 54 - column 11, line 61).

Schechter et al. disclose the claimed invention except for the saline solution feeding passage and the bone fragment exhausting passage formed in the rod of the cutter. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Schechter et al. with both the saline solution feeding passage and the bone fragment exhausting passage formed in the rod of the cutter in order to minimize the overall size of the device to accommodate for a small incision used with percutaneous surgery, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893)

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schechter et al. (US Patent 5643304) in view of Dinger et al. (US Publication 2001/0037114) in further view of Willard et al. (US Patent 5419774) .

Schechter et al. disclose the claimed invention except for a bending portion being formed at a designated portion of the rod; and the cylindrical protector having a double tube structure so that the saline solution feeding passage is formed between two tubes, and is bent at a designated angle. Dinger et al. teach a cutting member (194) having a shaft (195) with a bent portion (Figure 10 and page 10, paragraph 0077). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Schechter et al. with the cutting member having a shaft with a bent portion in view of Dinger et al. in order to provide a device that mimics the natural curvature of the human head.

Schechter et al. in view of Dinger et al. disclose the claimed invention except for the cylindrical protector having a double tube structure so that the saline solution feeding passage is formed between two tubes. Willard et al. teach a cutting device (10) having a protector (19 and 20) having a double tube structure (Figure 4 and column 5, lines 38-65). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Schechter et al. in view of Dinger et al. with the protector having a double tube structure in view of Willard et al. in order to keep the irrigation fluid separate from the rod to avoid damage to the rod and contamination of the irrigation fluid.

Response to Arguments

Applicant's arguments filed 16 November 2009 have been fully considered but they are not persuasive. The applicant argues that "Schechter et al. do not provide a plurality of non-plugging holes for exhausting the cut bone fragments." The examiner was clear in the Final Rejection, mailed 16 June 2009, that the embodiment used in the rejection of claims 1-5 was that of Figure 4. The applicant argues a cutting opening (89) as shown in Figure 3 which is not the embodiment used in the rejection. The embodiments of Figure 4 does indeed comprise a plurality (i.e. at least two shown) of non-plugging holes (109) for exhausting the cut bone fragments (column 11, lines 41-61).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

This is an RCE of applicant's earlier Application No. 10/519442. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry E. Waggle, Jr whose telephone number is 571-270-7110. The examiner can normally be reached on Monday through Thursday, 6:30am to 5pm, EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Larry E Waggle, Jr/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775